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Norcross, Georgia 30092

In re Application of
Christophe LELEU
Application No.: 09/914,512
PCT No.: PCT/FR00/00484
Int. Filing Date: 25 February 2000
Priority Date: 03 March 1999
Attorney's Docket No.: 74.0241
For: A Method And Apparatus For Measuring
... Particular An Ultrasound Signal

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: DECISION ON
:
: PETITION
:
: UNDER 37 CFR 1.47(b)
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This decision is in response to applicant's "PETITION " filed on 15 June 2002, which is being treated as petition under 37 CFR 1.47(b) that seeks the acceptance of the application without the signature of the inventor Christophe LELEU.

BACKGROUND

On 25 February 2000, applicant filed international application PCT/FR00/00484, which claimed priority of an earlier French application filed 03 March 1999. A copy of the international application was transmitted to the United States from the International Bureau on 08 September 2000. A Demand was filed on 20 September 2000. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 September 2001.

On 29 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), and a purported translation of the international application. No oath or declaration was submitted at such time.

On 12 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification also indicated that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two month from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 15 January 2002, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) a Declaration, Power of Attorney signed by Henri Dupont, Attorney in Fact
- 3) the required petition fee; and
- 4) a petition and fee for a two-month extension of time.

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), (3), (5) and (6), but not items (2) and (4) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been charged to applicant's representative deposit account.

Regarding requirement (2), although applicant has concluded that Mr. LELEU has refused to sign the declaration the petition does not include sufficient proof to establish that inventor Mr. LELEU has refused to execute the application. The standards for proof are set forth in MPEP § 409.03(d), which provides:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted....

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Mr. Pojunas states that Mr. LELEU refused to signed the declaration as well as the assignment, however in the present instance, it is not clear whether a complete set of application papers were presented to Mr. LELEU to sign. It is noted that no documentary evidence has been introduced into the file record that Mr. LELEU was presented with the declaration, let alone the complete application. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. It would appear, from Mr. Pojunas' statement that Mr. LELEU was only given the declaration and the assignment to sign and not a complete copy of the application.

Regarding item (3), applicant has stated the last known address of the inventor:

Invensys Metering Systems
Turbimax Industria de Hidrometros Ltda
Rua Christiano Kilmeyers, 819-B
13.460-000 Nova Odessa, SP
Brazil

Regarding item (4) a declaration has been provided executed by Mr. Henri Dupont, Attorney in Fact, stating that he is authorized to sign on behalf of the corporation for the non-signing sole inventor, Mr. LELEU. However, the declaration fails to set forth the citizenship of the inventor.

Regarding item (5) applicant has submitted proof that applicant has sufficient proprietary interest in the application because a signed Invention Specification (Exhibit A) and its English translation has been provided with the petition. This agreement acknowledges ownership of the invention by Schlumberger Industries, S.A.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage that will result if the present patent application is deemed abandoned for failure to submit a signed Oath or declaration of the Inventor.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

A review of the purported translation reveals that it is not an accurate translation of the application as original filed. For instance, on page 1, 10 Mhz is indicated in the national stage application instead of 1 Mhz as stated in the international application. Also, the discussion of DE 4017022 and 5777230 are not present in the international application.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. A translation of the international application and the \$130.00 processing fee as required in response to the decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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